

Amendment

U.S. Patent Application No. 09/652,793

REMARKS

Claims 3-4, 8-14, 16-23, and 48-86 are pending in the subject application, and all of the claims have been examined and stand rejected. Favorable reconsideration of the application and allowance of all of the pending claims are respectfully requested in view of the following remarks.

Applicant has amended claim 3 to correct a minor typographical error. This amendment is not in response to any rejection and does not affect the scope of the claim in any manner.

Claims 3, 4 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,025,261 to Ohta et al. in view of U.S. Patent No. 5,579,535 to Orlen et al. Further, dependent claims 9-11 stand rejected in further view of U.S. Patent No. 5,930,729 to Khamis et al., dependent claims 12-14 and 16 stand rejected in further view of U.S. Patent No. 5,438,695 to Morimura et al., dependent claims 17-23 stand rejected in further view of U.S. Patent No. 5,802,492 to Delorme et al., dependent claims 55-57 stand rejected in further view of U.S. Patent No. 5,774,827 to Smith, Jr. et al., and dependent claims 58-64 stand rejected in further view of U.S. Patent No. 5,365,451 to Wang et al.

Claims 48-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ohta in view of Orlen and further in view of U.S. Patent No. 5,703,598 to Emmons. Further dependent claim 54 (54/48) stands rejected as being unpatentable over Ohta in view of Orlen and Smith, Jr. (this rejection appears to be in error, since Emmons is cited against parent claim 48 but not dependent claim 54).

Finally, claims 65-86 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ohta in view of Orlen and Wang. Applicant respectfully traverses all of these rejections for the following reasons.

By way of overview, the present rejections are similar to those previously asserted, except that the Examiner now relies upon the Orlen patent rather than on Tendler (which is not prior art). Each of these rejections will be addressed below in detail. However, since the new aspects of Applicant's arguments relate primarily to Orlen, for the Examiner's convenience, Applicant first briefly summarizes the deficiencies of Orlen. Essentially, the Examiner now

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relies upon Orlen for a teaching of: sending present position information and the selection signal over a bi-directional wireless link (independent claims 3 and 65); receiving position related information that is a function of the present position information and the selection signal (independent claims 3, 65 and 68-70), and the position reporting enabling unit configured to selectively enable and disable the transmission of position information while mobile communication device is operational (independent claim 48). Applicant respectfully submits that Orlen does not disclose these fundamental elements of independent claims 3, 48, 65 and 68-70 for which purpose Orlen is cited. In particular:

1. Orlen does not disclose a mobile communication device sending its present position information over a bi-directional wireless link (as required by claims 3, 48, 65 and 70);
2. Orlen does not disclose a mobile communication device sending the combination of its present position information and the selection signal over a bi-directional wireless link (as required by claims 3 and 65);
3. Orlen does not disclose a mobile communication device receiving position-related information that is a function of the present position information and the selection signal over a bi-directional wireless link (as required by claims 3, 65, 68, 69, 70); and
4. Orlen does not disclose a mobile communication device comprising a position reporting enabling unit configured to selectively enable and disable transmission of the (mobile device's own) position information while said mobile communication device is operational (as required by claim 48).

These deficiencies are discussed in greater detail below in relation to the various rejections.

With regard to the rejection of claims 3, 4 and 8 over Ohta and Orlen, independent claim 3 sets forth a mobile communication device for use by a mobile user. The claimed mobile communication device includes: an input device that receives from an operator a selection signal indicative of a topic of interest; means for sending present position information of the mobile communication device and the selection signal over a bi-directional wireless link; and means for

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receiving position-related information that is a function of the present position information and the selection signal.

As the Examiner correctly acknowledges, Ohta fails to disclose an input device and the operator selection, the means for sending present position information and the selection signal over a bi-directional wireless link, and means for receiving position related information, as required by claim 3. Although not acknowledged by the Examiner, Ohta also fails to disclose or suggest means for sending both present position information and the selection signal over a bi-directional wireless link and for receiving position-related information that is a function of both the present position information and the selection signal, as required by claim 3.

These differences between the claimed invention and Ohta are more fundamental than suggested by the Examiner's analysis. The system described by Ohta is simply a map displaying system. Position data is collected by Ohta's vehicle and transmitted to a remote key station that supplies related map data to the vehicle in return. Not only does Ohta lack an input device for receiving a selection signal indicative of a topic of interest; there is not the slightest suggestion in Ohta's disclosure to accept any sort of selection signal from a user or to receive position-related information from a remote server based on both position information and a topic selection signal. The map data accessed at Ohta's remote key station is retrieved based only on position data. Ohta does not disclose or suggest also transmitting a selection signal along with the position data, and then retrieving map data (or any kind of information) as a function of both position data and a selection signal indicative of a topic of interest.

The requirement of claim 3 of the mobile communication device sending both position information and the selection signal over a bi-directional wireless link and receiving position-related information that is a function of both the position information and the selection signal is a fundamental aspect of the novelty of Applicant's claimed invention. In essence, the claimed device retrieves position-related information based on the combination of position information and a topic selection signal. There is not the slightest suggestion in Ohta's disclosure of how or why one would expand a map displaying system to be a fundamentally different type of system

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that permits selection of a topic of interest and then conveys information on that topic of interest as a function of user position and of the topic selection itself.

Orlen does not make up for the deficiencies of Ohta, since Orlen also fails to disclose or suggest a device sending both its present position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link, as required by claim 3, and because Orlen fails to disclose or suggest a mobile device receiving position-related information that is a function of both the mobile device's present position information and the selection signal, as required by claim 3.

The radiotelephone in Orlen does not acquire its present position information, cannot send its present position information (for it has none to send), and cannot send both its present position information (for it has none to send) and the selection signal over the bi-directional wireless link. In addition, Orlen fails to disclose the receiving of position-related information that is a function of both the present position information (of the mobile device) and the selection signal. The present position information of the mobile device is never acquired or sent by the mobile device (or determined in any manner) in Orlen and, therefore, the information received by Orlen's radiotelephone cannot be a function of both the present position information of the mobile device and the selection signal.

In fact, there is no language in Orlen that discloses, suggests, or even obliquely alludes to a mobile device determining or sending its present position information. Referring specifically to Examiner's references to Orlen's Abstract, col. 1, lines 50 – 60, and col. 2, lines 44 – 64, Orlen's Abstract is absolutely silent with respect to the sending of present position information and also fails to disclose the sending of the combination of present position information and a selection signal, and the receiving of position-related information that is a function of the present position information and the selection signal, all of which are fundamental requirements of claim 3.

At col. 1, lines 50-60, Orlen again fails to teach the mobile device (e.g. radiotelephone) sending its present position information. The only mention of positional information in col. 1, lines 50 – 60 is: "The data base includes at least positional information pertaining to relative

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locations of the transceiver stations...". In other words, the databases at the transceiver stations have positional information about the transceiver stations, not about the mobile device, and there is no mention whatsoever of the mobile device sending its present position information. Referring to col. 3, lines 41 – 47, "This positional information is preferably fixed and changes only when telepoint base stations are added or deleted from the personal communication system. Therefore, the positional information will generally only need to be transmitted to or stored in the telepoint base stations once...". Clearly, Orlen's reference to positional information actually excludes the mobile device and, if anything, teaches away from the sending of the present position information of a mobile communication device whose position is changing. The import of the word "present" in claim 3 is that, by its very nature, the position information of a mobile device is constantly changing and that it is the current, momentary value of that dynamically changing position which is of paramount importance. In fact, there is no place in the Orlen document whatsoever in which the mobile communication device (e.g. radiotelephone) sends its own present position information. Indeed, Orlen is completely silent as to a mobile communication device having the means to acquire or generate its own present position information let alone send its present position information. Therefore, Orlen cannot teach a mobile communication device for use by a mobile user comprising means for sending present position information and the selection signal over bi-directional wireless link; and means for receiving position-related information that is a function of the present position information and the selection signal.

At col. 2, lines 44-64 (cited by the Examiner) Orlen describes a wireless communication system consisting of a plurality of transceiver stations and portable radiotelephones. However, this passage is absolutely silent on the mobile device sending its present position information and the selection signal over a bi-directional wireless link and on receiving position-related information that is a function of the present position information and the selection signal.

Since Ohta and Orlen do not disclose or suggest any means for sending present position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link or any means for receiving position-related information that is a function of the

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position information and the selection signal, the subject matter of claim 3 would not have been (and could not have been) obvious from any combination of these documents.

Moreover, Applicant respectfully submits that there is no obvious way to modify Ohta in view of Orlen to meet the limitations of claim 3. Ohta is simply a map displaying system, wherein map data is retrieved from a remote key station so as to depict the location of the moving vehicle. In order meet the limitations of claim 3, one would have to dramatically alter Ohta's system to be something completely different. First, a user interface (together with supporting processing) would be required in order to present the user with the opportunity to select a topic of interest. Second, the selected topic of interest would need to be transmitted along with position information over a wireless link. Third, position-related information that is a function of both the position information and the topic selection signal would have to be received by the device.

Orlen could not possibly suggest all these modifications, since Orlen's system itself does not operate in this manner. Orlen is a communication system in which the current position of the mobile device is never determined and never transmitted. Therefore, it does not disclose the mobile device sending its present position information and selection signal over a bi-directional wireless link. Similarly, Orlen does not disclose the mobile device receiving position-related information that is a function of both the position information (of the mobile device) and the topic selection signal. More generally, Applicant respectfully submits that no reference could reasonably suggest modifying a map displaying system such as Ohta's to be a position-related information retrieval system given the extensive differences between such systems. Only by use of impermissible hindsight could one reasonably conclude that Ohta could be modified to meet the requirements of claim 3. For all of the foregoing reasons, Applicant respectfully submits that claim 3 and its dependent claims 4 and 8 would not have been obvious over Ohta in view of Orlen, and the Examiner is respectfully requested to reconsider and withdraw this rejection.

With regard to the rejections of dependent claims 9-11 in further view of Khamis, Khamis has been further cited for particular limitations found in dependent claims 9-11. However, like Ohta and Orlen, Khamis does not disclose or suggest any means for sending

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present position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link and for receiving position-related information that is a function of the position information and the selection signal. Thus, no combination of these documents would have (or could have) rendered obvious the subject matter of parent claim 3, and dependent claims 9-11 should be patentable at least by virtue of their dependence on parent claim 3. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 9-11.

With regard to the rejection of dependent claims 12-14, and 16 in further view of Morimura, like Ohta and Orlen, Morimura does not disclose or suggest any means for sending present position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link and for receiving position-related information that is a function of the position information and the selection signal. Thus, no combination of these documents would have (or could have) rendered obvious the subject matter of parent claim 3, and dependent claims 12-14 and 16 should be patentable at least by virtue of their dependence on parent claim 3. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

With regard to the rejections of dependent claims 17-23, DeLorme has been further cited for particular limitations found in these dependent claims. However, like Ohta and Orlen, DeLorme does not disclose or suggest any means for sending position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link and for receiving position-related information that is a function of the position information and the selection signal. DeLorme essentially discloses a desktop computer system that permits a user to engage in an iterative trip planning process in which a travel route can be prospectively determined or adjusted based on user-specified points of interest which lie along a travel route. Included among the various embodiments described by DeLorme is an in-vehicle embodiment in which a user can view the vehicle's current position and can also browse information about points of interest. However, whether desktop or in-vehicle, the system of DeLorme involves retrieving information stored in the local system. In particular, there is no suggestion in the description of DeLorme's in-vehicle embodiment of any means that sends position information

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and a selection signal indicative of a selected topic of interest over a wireless link or means that receives position-related information that is a function of the position information and the selection signal. Rather, the map and point of interest information is contained within DeLorme's device. Consequently, DeLorme's system does not send position information and a selection signal over a wireless link or receive corresponding position-related information.

Further, claim 3 requires that the position-related information be a function of both the present position information and the topic selection signal. In contrast, the point of interest information accessed in DeLorme is not a function of position information indicative of the present position of the device. In DeLorme's desktop embodiment, the location of the desktop system is entirely irrelevant to the iterative trip planning process performed on the system. Even in DeLorme's in-vehicle embodiment, the selection and display of a point of interest is decoupled from the current position of the vehicle. For example, at column 18, lines 1-9, DeLorme explains that current position of the vehicle is displayed on a visual route map, while at the same time, a passenger can browse through places to eat in Seattle using a restaurant list box. As described, this restaurant list box is not retrieved as a function of the current position of the vehicle, but rather as a separate selection of the passenger, which selection can be independent of the current position of the vehicle (presumably, the passenger would be free to "browse" restaurant information in other locales). Thus, DeLorme does not suggest receiving position-related information as a function of both current position information and a selected topic of interest. Consequently, no combination of Ohta, Orlen and DeLorme's disclosures could have rendered obvious the subject matter of parent claim 3, and dependent claims 17-23 should be patentable at least by virtue of their dependence on parent claim 3. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

With regard to the rejection of dependent claims 58-64 in further view of Wang, like Ohta and Orlen, Wang does not disclose or suggest any means for sending present position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link and for receiving position-related information that is a function of the position information and the selection signal. Thus, no combination of these documents would have (or

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could have) rendered obvious the subject matter of parent claim 3, and dependent claims 58-64 should be patentable at least by virtue of their dependence on parent claim 3.

With regard to the rejection of claims 48-53 as being unpatentable over Ohta and Orlen and further in view of Emmons, Applicant notes that Declarations under 37 C.F.R. §1.131 were submitted by both inventors with the previous Response filed on November 26, 2003. These Declarations, along with supporting documentation, established that the claimed invention was conceived and reduced to practice prior to February 28, 1996 (for the purpose of eliminating the Tendler publication as prior art under 35 U.S.C. §102(e)). In the present Office Action, the Examiner acknowledged and accepted Applicant's establishment of a date of invention prior to February 28, 1996. The effective filing date of the subject application is August 15, 1996. Emmons issued on December 30, 1997 and was filed on May 24, 1996. Thus, the earlier-submitted Declarations also eliminate Emmons as prior art under §102(e) (as seen from its issue date, Emmons is not prior art under any other provision of §102). Accordingly, Emmons cannot be relied upon in any rejection of the claims under 35 U.S.C. §103. Applicant respectfully submits that claims 48-53 would be patentable over the remaining cited documents for the reasons of record stated in previous responses. Since the rejections of claims 48 - 53 rely upon Emmons, the Examiner is respectfully requested to withdraw the rejections of claims 48 - 53 in view of the previously-submitted Declarations.

The same is true for the Smith, Jr. patent, which issued on June 30, 1998 and was filed on April 3, 1996 (i.e., after February 28, 1996). Smith, Jr. is relied upon in combination with Ohta and Orlen to reject claims 54-57 (claim 54 depends from independent claim 48, while claims 55-57 depend from independent claim 3; thus, it would appear that any rejection of claim 54 would more properly follow from a rejection relating to claim 48). Smith, Jr. is not prior art under 35 U.S.C. §102(e) or any other provision of §102; thus, it cannot be relied upon in any rejection of the claims under 35 U.S.C. §103. Applicant respectfully submits that claims 54-57 would be patentable over the remaining cited documents at least for the reasons stated with respect to parent claims 3 and 48. Accordingly, the Examiner is respectfully requested to withdraw the rejections to claims 54-57 in view of the previously-submitted Declarations.

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With regard to the rejection of independent claims 65, 68, 69 and 70 (as well as dependent claims 66, 67 and 71-86) over Ohta, Orlen and Wang, the Examiner merely refers back to his remarks relating to claim 3. Preliminarily, Applicant wishes to point out some significant irregularities in this rejection. The rejection of claim 3 relies only on Ohta and Orlen, not Wang; thus, by the Examiner referring back to claim 3, it is not clear what relevance Wang has to the rejection of at least independent claims 65, 68, 69 and 70. Further, the rejection of independent claim 70 also refers back to the rejection of claim 63, which in turn refers back to the rejection of claim 18. However, Delorme was relied upon in rejecting claim 18, but not relied upon in rejecting claim 70; thus, it is not clear what basis the Examiner is using for arguing obviousness of this claim. With regard to rejection of a number of dependent claims (i.e., claims 76 and 78-86), the Examiner refers back to corresponding claims that depend from claim 3. However, the Morimura and Delorme patents were relied upon to reject the relevant claims depending from claim 3, whereas these patents are not relied upon to reject claims 76 and 78-86; thus, it is unclear what basis the Examiner is using for arguing obviousness of these claims. Moreover, the Office Action contains no arguments relating to claim 77.

In any event, the subject matter of independent claims 65, 68, 69 and 70 and their dependent claims would not have been obvious from Ohta, Orlen and Wang for essentially the same reasons that this combination of references does not render obvious the subject matter of claim 3 (Wang does not make up for the deficiencies of Ohta and Orlen as noted above with respect to claims 58-64). In particular, independent claim 65 sets forth a method whose steps are analogous to the elements of claim 3. As explained above Ohta, Orlen and Wang all fail to disclose or suggest sending present position information of a mobile communication device and a selection signal over a bi-directional wireless link from the mobile communication device and receiving over the bi-directional wireless link position-related information that is a function of the present position information and the selection signal; thus, claim 65 and its dependent claims would not have been (and could not have been) obvious from any combination of these documents.

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Independent claim 68 sets forth a mobile communication device that includes, *inter alia*, means for receiving position-related information that is a function of a present position of the mobile communication device and the selection signal. Similarly, independent claim 69 sets forth a method of receiving position-related information via a mobile communication device that includes, *inter alia*, receiving over the bi-directional wireless link position-related information that is a function of a present position of the mobile communication device and the selection signal. Like claim 3, these claims require that the position-related information received over the wireless link be a function of both the present position of the mobile communication device and the selection signal; thus, these claims should be patentable over the prior art of record, as discussed in detail above. Independent claim 70 sets forth a mobile communication device that includes, *inter alia*, means for receiving position-related information that is a function of the present position information and at least one user-selected topic of interest. Like claim 3, the requirement of claim 70 of receiving position-related information that is a function of the present position information and at least one user-selected topic of interest is not disclosed or suggested by any one or combination of the documents relied upon by the Examiner; accordingly, claim 70 and its dependent claims should be allowable for reasons stated above. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 65-86.

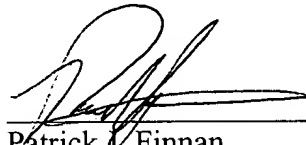
In view of the foregoing, Applicant respectfully requests the Examiner to find the application to be in condition for allowance with claims 3, 4, 8-14, 16-23 and 48-86. However, if for any reason the Examiner feels that the application is not now in condition for allowance, he is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application.

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 05-0460.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Finnan', is written over a horizontal line.

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